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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/464,099	12/22/99	BARRY	G MOBT: 175-2

HM12/0522

 EXAMINER

EWOLDT, G

 ART UNIT PAPER NUMBER

1644

DATE MAILED: 05/22/00 *C*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>09/464,099</b>	Applicant(s) <b>Barry et al.</b>
	Examiner <b>Gerald Ewoldt</b>	Group Art Unit <b>1644</b>

Responsive to communication(s) filed on 12/14/99 and 2/28/00.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 100-107 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims 100-107 are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

**DETAILED ACTION**

1. The location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Dr. Gerald Ewoldt, Art Unit 1644, Group 1640, Technology Center 1600.

2. Preliminary amendments filed 12/16/99 and 2/28/00 are acknowledged.

3. Claims 75-108 have been renumbered as claims 74-107 respectively, see 37 CFR 1.126. Accordingly, claims 1-99 have been canceled and pending claims 101-108 have been renumbered claims 100-107.

4. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 100-104 and 107, drawn to an antibody and a kit, classified in Class 530, subclasses 388.26 and 388.1 and Class 435, subclass 810.

II. Claims 105-106, drawn to a method of detecting an enzyme, classified in Class 435, subclass 7.1.

The inventions are distinct, each from the other because:

5. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)).

In the instant case, the product as claimed can be used in a materially different process such as for immunopurification of proteins.

6. Because these inventions are distinct for the reasons given above and Groups I-II have acquired a separate status in the art as shown by their different classification and/or the searches are not co-extensive and because the Groups encompass divergent subject matter, restriction for examination purposes as indicated is proper.

7. Should Applicant elect Group I, Applicant is further required under 35 U.S.C. § 121 to:

1) Elect a **specific** 5-enolpyruvylshikimate-3-phosphate synthase enzyme sequence with which the claimed antibody is immunoreactive.

2) List **all** Claims readable thereon including those subsequently added. Currently claim 101 is generic.

8. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The different amino acids recited for the degenerate positions of the enzyme of claim 100, such as glycine and arginine, would confer entirely different immunogenic properties on the enzyme molecule. Therefore, the species of Group I are independent and patentable over one another.

9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

11. A telephone call was made to Todd Rands on 5/11/00 to request an oral election to the above restriction requirement, but did not result in an election being made.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Gerald Ewoldt whose telephone number is (703) 308-9805. The examiner can normally be reached Monday through Thursday and every other Friday from 8:00 am to 5:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

G.R. Ewoldt, Ph.D.  
Patent Examiner  
Technology Center 1600  
May 12, 2000

*Christina Chan*  
CHRISTINA Y. CHAN  
SUPERVISORY PATENT EXAMINER  
GROUP 1644